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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,848	12/22/2003	Keith O. Cowan	030506 (BLL-0135)	9081
36192 7590 03/23/2007 CANTOR COLBURN LLP - BELL SOUTH 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER PULLIAM, CHRISTYANN R	
			ART UNIT	PAPER NUMBER
			2165	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/23/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/743,848

Applicant(s)

COWAN ET AL.

Examiner

Christyann Pulliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/22/2003 thru 2/16/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                                                  |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/20/2004 and 2/16/2007</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Claims 1-20 and 22 are pending as amended December 17, 2004.
2. Claim 21 was canceled in the preliminary amendment of December 17, 2004.
3. The original filing date of the application is December 22, 2003.
4. Two Information Disclosure Statements were filed on May 20, 2004 and February 16, 2007 respectively.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 21 in Figure 1. The specification or drawings can be amended to correct this problem. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of

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an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The disclosure is objected to because of the following informalities: undefined acronyms. Since acronyms can have multiple meanings and they can change over time even in the same field, at the first use of the acronym, the meaning should be spelled out. This was done for "VCR" and "DVR", but not for some other acronyms. Some examples include "IP", "ADSL", "DSL", "ILEC", "HPNA", "UWB" and "CPE". Appropriate correction is required.

### ***Claim Objections***

7. Claims 3, 7, 9, 10, 11 and 16 are objected to because of the following informalities:

Missing periods at the ends of Claims 3, 9, and 16; and

Missing "and" between the last two steps in Claims 7, 10, and 11.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for a claim covering every conceivable controller for implementing the recited method. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with this claim. In *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language. Claim 22 is drawn to any "controller," regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers* wherein "a DNA" and a result was recited. The CAFC stated in *Fiers* at 1606 "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived". See also *Ex parte Maize*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single means claims even though "means" was not literally used. Thus Claim 22 yields a "controller" that achieves a result without defining what will do so.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. There is a controller without any limiting structure, which leaves the scope virtually unlimited.

12. Claims 2, 8 and 15 recite the limitation "the percentage". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claim 14-19 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. Claim 14-19 and 22 are rejected under 35 U.S.C. 101 because they are software per se. The specification definition of medium on page 11 causes Claims 14-19 to contain non-statutory matter. Claim 22 can be implemented in software alone. There is

no proper computer-readable medium or hardware. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se.* ). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Additionally, the specification describes a computer readable medium to include non-statutory transmission mediums (See page 11 of the specification). Accordingly, Claims 14-19 and 22 are not statutory.

### ***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1-4, 6-10, 12-17, 19-20 and 22 are rejected under 35 U.S.C. 102(a)/(e) as being anticipated by Knight et al., U.S. Patent No. 6,721,748 (hereinafter Knight).

As for Claims 1, 7, and 14, Knight teaches:

allowing a consumer to join a community (See e.g. subscribers – col. 5, lines 9-14);

monitoring access to content by members of the community (See e.g. col. 6, lines 48-53);

determining a community interest in the content in response to members of the community accessing the content (See e.g. col. 6, lines 48-58); and

automatically distributing the content to the consumer over a distribution network in response to the community interest (See e.g. col. 6, lines 32-38).

As for Claims 2, 8, and 15, Knight teaches the parent Claims of 1, 7, and 14. Knight also teaches wherein: the community interest is determined based on the percentage of members in the community that have accessed the content (See e.g. col. 6, lines 38-53, col. 7, lines 14-18 Fig 3D hot list, and Claim 2).

As for Claims 3, 9, and 16, Knight teaches the parent Claims of 1-2, 7-8, and 14-15. Knight also teaches the community interest is compared to a reference to initiate



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the automatically distributing (See e.g. col. 6, lines 33-67).

As for Claims 4, 10, and 17, Knight teaches the parent Claims of 1, 7, and 14. Knight also teaches wherein: the automatically distributing includes storing the content on a consumer storage device associated with the consumer (See e.g. col. 6, lines 33-37 and lines 53-67).

As for Claims 6, 12, and 19, Knight teaches the parent Claims of 1, 7, and 14. Knight also teaches wherein: the automatically distributing the content is dependent on a consumer preference to receive automatically distributed content (See e.g. col. 23, lines 49-67).

As for Claim 20, Knight teaches the parent Claim 1. Knight also teaches wherein: the content includes at least one of video, audio and consumer-generated content (See e.g. col.8, lines 54-65).

As for Claim 22, Knight teaches:  
A controller for controlling distribution of content, the controller comprising:  
means for receiving input from a consumer to join a community (See e.g. subscribers – col. 5, lines 9-14),

means for receiving content having a community interest in the content in response to members of the community accessing the content (See e.g. col. 6, lines 38-53, col. 7, lines 14-18 Fig 3D hot list, and Claim 2); and

means for notifying the consumer that the content is available (See e.g. col. 26, lines 23-26- alerted and col. 23, lines 49-67).

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 5, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight as applied above, and further in view of Levinson, U.S. Patent No. 5,404,505 (hereinafter Levinson).

As for Claims 5, 11, and 18, Knight teaches the parent Claims of 1, 4, 7, 10, 14 and 16. Knight also teaches further comprising:

notifying the consumer that the content is available on the consumer storage device (See e.g. col. 26, lines 23-26- alerted and col. 23, lines 49-67).

Knight considers subscription fees (See e.g. Knight - col. 28, lines 23-34) and charging for the use of features (See e.g. Knight - col. 18, lines 42-45) but does not expressly

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teach billing a customer based on the content they view. However, Levinson teaches billing the consumer upon the consumer accessing the content on the consumer storage device (See e.g. Levinson – col. 4, lines 26-30).

Knight and Levinson are from the providing content to subscribers. It would have been obvious to one of ordinary skill in the art at the time the invention was made having the teachings of Knight and Levinson to have combined Knight and Levinson. The motivation to combine Knight and Levinson comes from common practice of charging consumers for a service. Knight has subscription fees (See e.g. Knight - col. 28, lines 23-34) and charging for the use of features (See e.g. Knight - col. 18, lines 42-45). Levinson provides a common enhancement to that billing system that links the charge to the content item accessed.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Konig et al. – U.S. Patent 6,981,040 provides individual product and service information based on user interests.

Pitkow et al. – U.S. Patent No. 7,031,961 provides a search and recommendation that provides content based on interests.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christyann Pulliam whose telephone number is 571-270-1007. The examiner can normally be reached on M-Th 8:30am-6pm, every other Fri 8:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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